

## REMARKS

Claims 1-26 are pending prior to entering this amendment. The Examiner rejected claims 1-24 and 26 under 35 U.S.C. 103(a) over Yamamoto (U.S. Patent No. 6,108,456) and Anderson (U.S. Patent No. 6,646,768). Applicants amend claims 1, 3-4, 6-9, 11, 13, 16-18, and 20-22, cancel claim 25, and add claims 27-31. Claims 1-24 and 26-31 remain after entering this amendment. Applicants add no new matter and request reconsideration.

### Allowable Subject Matter

The Examiner objects to claim 25 as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the elements of the base claim and any intervening claims. Applicant has elected to rewrite claim 25 into independent claim 8, which places claims 8-10, and 26 in condition for allowance.

### Claim Rejections – 35 USC § 103

The Examiner rejected claims 1-24 and 26 under 35 U.S.C. 103(a) over Yamamoto and Anderson. Applicants respectfully traverse the Examiner's rejection.

Claim 1 recites *moving a document a first distance in a first direction and moving said scanning head a second distance in the first direction, wherein said second distance is smaller than said first distance*.

The Examiner alleges Yamamoto's recording paper 311 discloses the recited document, and Yamamoto's recording head 301 discloses the recited scanning head. Yamamoto, however, does not teach or suggest *moving a document a first distance in a first direction and moving said scanning head a second distance in the first direction* as the claim recites. See, Yamamoto, Figure 3, col. 3, lines 16-44, where Yamamoto's recording paper 311 and recording head 301 move in different directions, for example, the recording paper 311 is conveyed in direction "a" and the recording head 301 slides along guide shafts 304 and 305 in direction "b" which is orthogonal to direction "a". Nothing in Anderson cures this deficiency, as Anderson's image sensor assembly 33 "is maintained at a fixed position under the contact glass plate 13 in the ADF scan window 43 while scanning ADF fed documents." See, e.g., Anderson, Figure 2; col. 6, lines 1-8. Claim 1 and its corresponding dependent claims therefore are patentable over the combination of Yamamoto and Anderson.

Applicants further agree with the Examiner that Yamamoto does not disclose the recited *wherein said second distance is smaller than said first distance* claim feature. Office Action, 10/16/2007, page 3. The Examiner, however, argues “[i]t appears that no particular advantage would have been achieved by setting the distance of the feed and scan head, thus one of ordinary skill in the art would have known to set the feed and scan directions at a distance sufficient to achieve a scanning result while simultaneously feeding the paper as a matter of convenience or design choice.” Office Action, 10/16/2007, page 3.

Applicants note that under MPEP § 2143, a proper *prima facie* obviousness rejection must disclose one or more references that teach every claim element or would be obviously modified by one skilled in the art to arrive at the claimed invention. This is further supported by the recent *KSR* decision, whereby the Supreme Court acknowledged the importance of identifying “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does” in an obviousness determination. *KSR*, 127 S. Ct. 1727 at 1731 (2007).

In the instant rejection, the Examiner identifies no teaching or suggestion in Yamamoto or provides a reason that one skilled in the art would be motivated to modify Yamamoto and disclose *moving a document a first distance in a first direction and moving said scanning head a second distance in the first direction, wherein said second distance is smaller than said first distance*. In fact, the purported modification of Yamamoto suggested by the Examiner would reduce, if not destroy, the ability of Yamamoto’s serial scanner apparatus to effectively scan the recording paper 311. For instance, if Yamamoto’s paper feed roller 311 moved the recording sheet 311 a greater distance than the recording head 301, large sections of the recording paper 311 would not be scanned by the recording head 301. Since any modification of Yamamoto in an attempt to disclose the recited claim features would essentially destroy the principle operation of the serial scanner apparatus, claim 1 and its corresponding dependent claims are patentable over the combination of Yamamoto and Anderson.

Claims 6, 11, 16, and 20 recite feature generally similar to those recited above in claim 1, and therefore for at least the reasons discussed above are also patentable over the combination of Yamamoto and Anderson.

### **New Claims**

Applicants add claims 27-31, which depend from independent claims 1, 6, 11, 16, and 20, respectively, and are patentable based at least on their dependency to those independent claims, as discussed above. Furthermore, these newly added claims include features generally similar to those the Examiner deemed allowable over the cited references in claim 25, currently rewritten into independent claim 8, and therefore are patentable for similar reasons.

### **CONCLUSION**

For the foregoing reasons, reconsideration and allowance of all claims of the application as amended is requested. The Examiner is encouraged to telephone the undersigned at (503) 224-2170 if it appears that an interview would be helpful in advancing the case.

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Respectfully submitted,

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